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Marcus Escobosa

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GREENBERG TRAURIG, LLP  
77 WEST WACKER DRIVE  
SUITE 2500  
CHICAGO, IL 60601-1732

EXAMINER

ZIMMERMAN, BRIAN A

ART UNIT

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application Number: 09/615,473  
Filing Date: July 13, 2000  
Appellant(s): ESCOBOSA ET AL.

**MAILED**

**MAR 23 2007**

**GROUP 2600**

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Gary R. Jarosik  
For Appellant

**SUPPLEMENTAL EXAMINER'S ANSWER**

This is in response to the reply brief filed 2/21/07 appealing from the Office action  
mailed 9/25/06.

The final office action was 9/25/06. The appellant filed an appeal brief 10/10/06. The examiner responded with an examiner's answer 1/3/07 that included a new grounds of rejection. This Supplemental Examiner's Answer is in response to the appellant's reply brief filed 2/21/07. This supplemental answer will address the appellant's arguments only directed to the new grounds of rejection. Any appellant's comments concerning previous rejections have been addressed in the original examiner's answer and are incorporated herein. Elements not discussed here are incorporated by reference from the Examiner's Answer.

## **(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner, which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

US Application 10/151635, filed 5/20/02, rejection reversed by the Board of Appeals 12/20/06. A copy of the Decision is attached to the Reply Brief (2/21/07)

US Application 10/411792, filed 4/11/03, rejection Affirmed by the Board of Appeals 10/6/06. A copy of the Decision is attached to the first Examiner's Answer (1/3/07).

**(8) Evidence Relied Upon**

The following is a list of the references relied upon in the rejections against the claims:

6008735	Chiloyan et al	12-1999
6211870	Foster	4-2001
WO 00/17738	Kemink	3-2000

**(10) Response to Argument**

In the reply brief, the appellant argues that there are no references cited to teach or suggest that it would have been desirable to increase the efficiency in the user experimentation phase of the remote control (of Chiloyan). In response to appellant's argument that there is no suggestion to combine from other references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the rejection is based one of ordinary skill in the art being motivated to make the modification to improve efficiency in the programming of the remote controller.

The appellant wants a reference to be cited to teach that efficiency in programming is a desirable feature. First it noted that motivation need not be found from a reference but can come from knowledge generally available to one of ordinary

Art Unit: 2612

skill in the art. It remains the examiner's position that the artisan at the time of the art would be well aware of the desirability to provide efficiency in the programming mode of a remote control since users definitely wouldn't want to spend hours programming their remote control. Therefore, any and all steps leading to increased efficiency in the programming of the remote control would have been desirable in a programmable remote control.

For the appellant to imply that efficiency is undesirable is unsubstantiated to say the least. One of ordinary skill in the art clearly wants to make the user's experience enjoyable at best, and in the case of setting up an electronic system, the least painful to the user.

Furthermore Chiloyan itself points to the desire to increase programming efficiency by electing possible code sets to experiment thus improving efficiency in the experimentation mode of programming as compared to experimenting with all possible code sets.

The appellant argues that the system of Chiloyan is already efficient during the first experimentation mode (experimenting with the codes on the remote controller) then there would be no reason to be efficient during the second mode. Quite the opposite is true. Chiloyan does teach to improve programming (or setup) efficiency during the first mode thus indicating that it is desirable to further make the system as simple or efficient to set up as possible.

The appellant puts forth a discussion of how they believe Kimink teaches away from the claimed invention (still discussing claim 54). Kimink is not cited in the rejection.

Art Unit: 2612

The applicant cannot argue that the reference to Kimink teaches the non obviousness of the claims over Chiloyan because such an argument does not make sense when the rejection of claim 54 does not include Kimink.

Kimink is cited in the rejection of claims 60,71,72,74,76,78-80. The appellant restates the arguments regarding these claims (specifically claim 71) from the original appeal brief. The examiner points to the remarks section of the original examiner's answer and incorporates those comments herein.

**(11) Related Proceeding(s) Appendix**

Page 6

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Brian Zimmerman

**BRIAN ZIMMERMAN**  
**PRIMARY EXAMINER**

**DANIEL WU**  
**SUPERVISORY PATENT EXAMINER**